

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Michael I. Rosenfelt	§	ATTORNEY DOCKET NO.:
	§	1744-702USPT
	§	
Serial No.: 10/805,907	§	Confirmation No.: 2039
	§	
Filed: March 22, 2004	§	Examiner: Justin Ye Lee
	§	
For: METHOD AND SYSTEM FOR	§	Art Unit: 2617
PROVIDING BACKUP MESSAGES TO	§	
WIRELESS DEVICES DURING	§	
OUTAGES	§	

APPEAL BRIEF UNDER 37 C.F.R. 41.37

Board of Patent Appeal and Interferences
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 1-10, 17-19, 21-23 and 25- 34 in the above-identified application. A Notice of Appeal was filed on July 15, 2008. Please charge the fee of \$510.00 as set out under 37 C.F.R. §41.20(b)(2) for filing the brief, as well as any additional required fees, to **Deposit Account No. 50-3468**.

REAL PARTY IN INTEREST

The real party in interest in the present case is MessageOne Inc., a Delaware corporation ("**Appellant**"), by assignment of the original inventors recorded at Reel 014967, Frame 0422.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, or the Appellant's legal representative, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

The present application was filed with 48 claims. Claims 11-16, 20, 24, 35-48 were previously withdrawn from consideration. Accordingly, Claims 1-10, 17-19, 21-23, and 25-34 are pending in this application and stand rejected by the Examiner as noted in the Final Office Action dated April 17, 2008. The rejection of Claims 1-10, 17-19, 21-23, and 25-34 is appealed. A current version of the pending claims is set forth in the attached Appendix A in accordance with 37 C.F.R. 41.37(c)(1)(viii).

STATUS OF AMENDMENTS

No amendments to the claims have been filed or entered subsequent to the final rejection but, in response to a restriction election imposed in the Examiner's final rejection, Appellant submitted, after the notice of appeal was filed but prior to the filing of this brief, an election of Claims 1 – 10, 17 – 19, 21 – 23 and 25 – 34 for examination.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a method and system for providing email to a wireless device during an outage in the users' original email system. (Appellant's Patent Application Publication US 2005/0003807A1 ("*Appellant's Specification*"), paragraph 16). More particularly, Appellant's invention involves providing electronic messaging services to wireless devices during outages by:

- (A) sending email messages from a primary email system to a user's wireless device;
- (B) when said primary email system is unavailable, redirecting said email messages from said primary email system to a secondary email system and from said secondary email system to said user's wireless device;

(C) notifying said user that said email messages are available on said user's wireless device through said secondary email system at such time as said redirection of said email messages has been implemented;

(D) at such time as said primary email service becomes available, redirecting said email messages from said secondary email system to said primary email system and from said primary email system to said user's wireless device;

(E) notifying said user that said email messages are available on said user's wireless device through said primary email system at such time as said redirection of said email messages has been implemented; and

(F) synchronizing said email messages received on said secondary email system while said primary email system was unavailable with the messages in said primary email system. (*Appellant's Specification*, paragraphs 16; paragraphs 29 through 37; and Fig. 2).

In other embodiments of Appellant's invention, one or more of the steps of notifying users that said email messages are available during or after an outage further include the automated delivery of a preexisting notification email message to an alternate email address for said users. (*Appellant's Specification*, paragraph 48). In yet another embodiment, the step of assessing the time at which said primary email system is available includes periodically pinging email addresses on said primary email system and evaluating whether a response is received from said email addresses. (*Appellant's Specification*, paragraph 35).

Finally, Appellant's invention is distinguished from solutions known in the art involving "entire email system" replication at "a remote datacenter" on similar hardware, "real-time database replication of disks at the byte level", and "transferring offline database backups on a server-by-server basis." (*Appellant's Specification*, paragraphs 6 and 27).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The Examiner has rejected Claims 1-5, 9, 10, 25-29, 33, and 34 under 35 U.S.C. 103(a) as being unpatentable over Pickup et al. (US 2003/0050984 A1) ("*Pickup*") in view of Easterbrook et al. (US 6,886,030 B1) ("*Easterbrook*") and further in view of Wallach et al. (US 6,292,905) ("*Wallach*").

2. The Examiner has rejected Claims 1-5, 9, 10, 25-29, 33, and 34 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of Mosher, Jr. (US 5,884,329) (“*Mosher*”).
3. The Examiner has rejected Claims 6, 8, 30, and 32 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Wallach* and as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Mosher*.
4. The Examiner has rejected Claims 7 and 31 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Wallach* and as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Mosher*.
5. The Examiner has rejected Claim 17 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of Katsikas (US 2003/0191969 A1) (“*Katsikas*”).
6. The Examiner has rejected Claim 18 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of *Easterbrook*.
7. The Examiner has rejected Claims 19 and 21 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of *Easterbrook*.
8. The Examiner has rejected Claims 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* and *Easterbrook* as applied to claim 21 and further in view of *Katsikas*.

ARGUMENT

1. Rejection of Claims 1-5, 9, 10, 25-29, 33, and 34 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Wallach*.

The Examiner’s position that *Pickup*, *Easterbrook* and *Wallach* are combinable to render the Appellant’s invention obvious should be overturned on appeal for at least the following reasons.

A. *The Examiner has not demonstrated that each claim element was independently known in the prior art.*

Courts have long held that “a patent comprised of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, --- U.S. ----, 127 S.Ct. 1727, 1741, 167 L.Ed.2d 705 (2007) (citing *United States v. Adams*, 383 U.S. 39, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966)). Here, however, the

Examiner's final rejection has failed to demonstrate that each of the several elements of independent claim 1 and independent claim 25 were known in the prior art.

Pickup is directed to a method for providing a text notification to a third party when the email address of the third party is unknown but the telephone number of the third party is known. *Pickup*, paragraphs 6-15. *Pickup* utilizes a third party's phone number to send the third party a notification, preferably in the form of a text message to the third party's mobile phone, indicating that email messages for the third party have arrived. *Pickup*, paragraphs 16 and 55. If the third party chooses to register with a particular website indicated in the text notification, the third party will be granted access to the email messages. *Pickup*, paragraph 15. *Pickup* does not teach or disclose, however, that the email messages themselves may be sent to a wireless device. *Id.* Instead, if the third party registers and provides an email address, the email messages are forwarded "over the Internet" to "an address" supplied by the third party—there is no disclosure of sending the email messages to the third party's mobile phone. *Pickup*, paragraph 55.

Pickup does disclose, as does the background section of *Appellant's Specification*, the use of an offsite replication-type backup system that has a mail server, a web server, and a mirrored copy of the database. *Pickup*, paragraph 57 and *Appellant's Specification*, paragraphs 6 and 27. In the event of operational errors, physical damage or catastrophic failure of the primary system, "incoming emails are automatically routed to the backup system 5 located at a separate site." *Pickup*, paragraph 57. *Appellant's Specification* acknowledges that such replication-type backup systems were known in the art and distinguishes such systems from Appellant's invention. *Appellant's Specification*, paragraphs 5-15 and 27. The stated purpose of the offsite replication-type backup system in *Pickup* is to allow the continued operation of the email redirection service disclosed by *Pickup*, namely, sending text messages to telephone numbers of third parties to inform them of the presence of email messages being held by the website service and granting the third parties access to the email messages if they choose to register with the website service. *Pickup*, paragraph 57. Importantly, *Pickup* does not disclose providing the email messages to wireless devices—whether through the replication-type backup system or otherwise. Moreover, *Pickup* does not disclose sending a notice to a third party when the primary system or backup system have been engaged or disengaged.

Easterbrook teaches a system with a primary communications link and a secondary communications link, both of which are active at the same time. *Easterbrook*; col. 5, lines 36-

48. The primary link is an expensive high bandwidth link and the secondary link is a less expensive low bandwidth link. *Easterbrook*; col. 3, lines 21-27 and 34-41. *Easterbrook* discloses a method of using the less expensive secondary link to continuously provide an “email notification” to a user when email messages have arrived for the user. *Easterbrook*; col. 3, lines 34-41. These email notifications, however, only contain “information on whether there are any new messages or not.” *Easterbrook*; col. 4, lines 31-32. The email notifications allow the user to periodically retrieve the email messages using the expensive primary link, rather than having to continuously use the expensive primary link to retrieve email messages, and, as a result, the user saves costs associated with continuous use of the expensive primary link. *See Easterbrook*; col. 5, lines 49-65. Importantly, both links are always concurrently active in *Easterbrook* so neither link serves as a backup for the other. Furthermore, *Easterbrook* effectively teaches away from sending email messages over the secondary link because *Easterbrook* characterizes the secondary link as being unidirectional and of a low bandwidth. *Easterbrook*; col. 3, lines 34-41. In addition, *Easterbrook* does not disclose sending a notice to a user when the primary link or the secondary link have been engaged or disengaged.

Wallach is directed to a method for improving the ability of a network to route around faulty components. *Wallach*; col. 1, lines 41-42. *Wallach* discloses the updating of a replica of an enhanced network directory database “to reflect the changes in a server-to-storage device configuration brought about by processes running on [a primary] server.” *Wallach*; col. 8, lines 1-7. *Wallach* does not disclose any use of -- and, in fact, contains absolutely no reference at all to -- email messages or wireless devices.

Appellant respectfully submits that the combination of *Pickup* in view of *Easterbrook* and in further view of *Wallach* fails to teach, disclose or render obvious at least one of the distinguishing features of independent claims 1 and 25. First, the distinguishing features of “redirecting said email messages ... to said user’s wireless devices” in independent claim 1 and “delivering email messages to said wireless devices” in independent claim 25 are not taught, disclosed, or rendered obvious. At most, *Pickup* discloses sending a notice to a wireless device that email messages are available for access through a website service. *Pickup* does not disclose redirecting the email messages themselves to a wireless device. Similarly, *Easterbrook* teaches away from a system whereby email messages are delivered over the secondary email system – in *Easterbrook* only the notifications are to be delivered over the inexpensive secondary link.

Finally, *Wallach*, as stated above, makes no mention of email messages or wireless devices. Consequently, Appellant respectfully requests that this rejection be overturned with respect to Claims 1-5, 9, 10, 25-29, 33, and 34 because the combination of *Pickup* in view of *Easterbrook* and in further view of *Wallach* fails to teach, disclose or render obvious the distinguishing feature of independent claims 1 and 25 cited above.

Second, the following four distinguishing features of independent claims 1 and 25 regarding notice of the availability of email messages through either the primary or secondary system are not taught, disclosed, or rendered obvious: (1) “notifying said user that said email messages are available on said user’s wireless device through said secondary email system at such time as said redirection of said email messages has been implemented” in independent claim 1; (2) “notifying said user that said email messages are available on said user’s wireless device through said primary email system at such time as said redirection of said email messages has been implemented” in independent claim 1; (3) “at such time as said primary email system becomes unavailable, users of said wireless devices are notified that said primary email system is unavailable” in independent claim 25; and (4) “at such time as said primary email service again becomes available ... notifying said users that said email messages are available on said users wireless devices through said primary email system” in independent claim 25. *Pickup* does not disclose sending a notice that and when the primary system or backup system have been engaged or disengaged. The only notifications disclosed by *Pickup* are the text message notices to third party telephone numbers indicating the presence of email messages being held by a website service and the opportunity to access the email messages through registration to the website service. Similarly, *Easterbrook* does not disclose sending a notice to users when a primary system or a backup system have been engaged or disengaged. As previously discussed, the email system described in *Easterbrook* does not disclose a backup system in which email messages are redirected during an outage, it discloses a system in which both links are concurrently active. Because *Easterbrook* does not disclose redirecting messages, *Easterbrook* cannot, and does not, teach a system whereby a notification is sent “at such time as said redirection of said email messages has been implemented.” Again, *Wallach*, as stated above, makes no mention of email messages or wireless devices. Because the combination of *Pickup* in view of *Easterbrook* and in further view of *Wallach* fail to teach, disclose or render obvious the

distinguishing features of independent claims 1 and 25 cited above, Appellant respectfully requests that this rejection be overturned with respect to Claims 1-5, 9, 10, 25-29, 33, and 34.

B. The Examiner has not supplied a Rational Underpinning for Combining References

Even if the Examiner could show that each claim limitation was present in the prior art, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356–57, 83 U.S.P.Q.2d 1169, 1174 (Fed. Cir. 2007), cert. denied, 2008 WL 833311 (U.S. 2008). In particular, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness in light of a combination of particular references. *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1373–74, 85 U.S.P.Q.2d 1641, 1647–48 (Fed. Cir. 2008) and *KSR Int'l Co. v. Teleflex Inc.*, --- U.S. ----, 127 S.Ct. 1727, 1741, 167 L.Ed.2d 705 (2007).

The Examiner's final rejection fails to satisfy even a flexible application of this standard because the reasoning cited by the Examiner's final rejection is unrelated to Appellant's invention. According to the Examiner's final rejection, the cost savings identified in *Easterbrook* of combining an inexpensive secondary link with the periodic use of an expensive primary link, to avoid continuously retrieving email messages with the expensive primary link, supplies the rational underpinning for combining *Easterbrook* with *Pickup* to arrive at the Appellant's invention. Final Rejection, Page 7, Paragraph 3 (citing *Easterbrook*, Col. 1, lines 27-38). Such cost savings, however, are impossible to achieve with Appellant's invention because Appellant's invention does not rely on an inexpensive secondary link to avoid the costs of continuously using an expensive primary link. As described throughout *Appellant's Specification*, the purpose of Appellant's invention is to provide email messages to wireless devices during an outage—not to reduce costs on checking email messages that are already otherwise available. *Appellant's Specification*, Abstract and paragraph 3. Consequently, the Examiner's final rejection fails to supply a rational underpinning necessary to support a combination of *Pickup* and *Easterbrook* that would justify a legal conclusion of obviousness with respect to independent claims 1 and 25. Because there is no rational underpinning for the combination of *Pickup* in view of *Easterbrook* and in further view of *Wallach*, Appellant

respectfully requests that this rejection be overturned with respect to Claims 1-5, 9, 10, 25-29, 33, and 34.

C. No Reasonable Expectation of Success exists in the prior art

The courts require that some reason or suggestion must be found in the prior art or other evidence of record that would have led one of ordinary skill in the art to produce the claimed invention in order to properly establish a prima facie case of obviousness. For example, in *In re Clinton*, 527 F.2d 1226, the CCPA stated that “obviousness does not require absolute predictability but a reasonable expectation of success is necessary.” *See also, Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356–57, 83 U.S.P.Q.2d 1169, 1174 (Fed. Cir. 2007), cert. denied, 2008 WL 833311 (U.S. 2008). The court went on to say that, “in going from the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led a person skilled in the art to do.” Accordingly, obviousness cannot be surmised when there is no suggestion, or expressed expectation, of success in the prior art that would have led one to perform the experimentation in the first place.

A careful reading of the cited prior art provides ample evidence that a person of ordinary skill in the art would not reasonably expect that the combination of *Easterbrook* and *Wallach* with *Pickup* would successfully lead to the limitations contained in Appellant’s independent claims 1 or 25. As discussed in detail above, *Pickup* discloses the use of an offsite replication-type backup system of a type that *Appellant’s Specification* distinguishes from Appellant’s invention. *Pickup*, paragraph 57 and *Appellant’s Specification*, paragraphs 5-15 and 27. The combination of the replication-type backup system disclosed in *Pickup* with the concurrently active expensive link and inexpensive link disclosed in *Easterbrook* would not reasonably be expected to successfully lead to the limitations contained in Appellant’s independent claims 1 or 25 for at least the following four reasons.

First, neither *Pickup* nor *Easterbrook* disclose the use of a secondary system to send email messages to wireless devices. At most, they disclose the use of a secondary system to send simple notifications that email messages may be accessed by some other means: a website service in the case of *Pickup* and an expensive primary link in the case of *Easterbrook*. In contrast, Appellant’s independent claims 1 or 25 clearly provide email messages to wireless devices via a secondary system during an outage.

Second, even if a person of ordinary skill in the art were to attempt to use the concurrently active expensive link and inexpensive link as disclosed by *Easterbrook* with the replication-type backup system disclosed in *Pickup*, such combination could not reasonably be expected to be successful because the secondary link in *Easterbrook* has “a relatively low bandwidth ... that is suitable for providing email notifications” and may be “unidirectional”. *Easterbrook*, Col. 3, lines 34-41. These secondary link features could not reasonably be expected to provide email messages – as is distinguished from email notifications by *Easterbrook* – to wireless devices during an outage of a primary system as claimed by independent claims 1 or 25. *See, Easterbrook*, Col. 4, lines 31-32 (defining “email notifications” to contain “information on whether there are any new messages or not”). Moreover, it is not even clear that the primary link disclosed by *Easterbrook* could reasonably be expected to provide email messages to wireless devices during outages as claimed by independent claims 1 or 25 because, the primary communications link in *Easterbrook* “preferably provides communications ... only occasionally when communications over the primary communications link 22 are necessary for reasons other than providing e-mail notifications.” *Easterbrook*, Col. 3, lines 21-27 (emphasis added).

Third, as discussed above, neither *Pickup* nor *Easterbrook* disclose the sending of a notification “at such time as said redirection of said email messages has been implemented.” While providing users with notice at the time of a redirection may seem obvious in hindsight, the prior art does not disclose such a limitation and the timing and content of these notices could be especially comforting to a user whose sensitive or urgent wireless email communications were traditionally backed-up by an unreliable system of the replication type disclosed in the prior art. *See, Appellant’s Specification*, paragraphs 9-15.

Fourth, *Wallach*, as stated above, makes no mention of email messages or wireless devices and, therefore, does not supply the reasonable expectation of success that is deficient in the combination of *Pickup* and *Easterbrook*.

For all of the above reasons, there is no reasonable expectation of success found in the combination of *Pickup* in view of *Easterbrook* and in further view of *Wallach* that would have led a person of ordinary skill in the art to arrive at the distinguishing features of independent claims 1 and 25, and Appellant respectfully requests that this rejection be overturned with respect to Claims 1-5, 9, 10, 25-29, 33, and 34.

2. Rejection of Claims 1-5, 9, 10, 25-29, 33, and 34 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Mosher*.

For the reasons stated above in section 1, Examiner's position that *Pickup*, *Easterbrook* and *Mosher* are combinable to render the Appellant's invention obvious is faulty. The Examiner cites *Mosher* only for the step of synchronizing email messages received on the secondary system while the primary email system was unavailable with the messages in the primary email system. Like *Wallach*, however, *Mosher* does not disclose any use of -- and, in fact, contains absolutely no reference at all to -- email messages or wireless devices. Consequently, the substitution of *Mosher* for *Wallach* continues to present the shortcomings identified by the above arguments in section 1. Appellant hereby incorporates the arguments presented in section 1 by reference and respectfully requests that this rejection be overturned with respect to Claims 1-5, 9, 10, 25-29, 33, and 34.

3. Rejection of Claims 6, 8, 30, and 32 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Wallach* and as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Mosher*.

For the reasons stated above in section 1 and section 2, Examiner's position that *Pickup*, *Easterbrook* and *Wallach* are combinable to render the Appellant's invention obvious is faulty and the Examiner's position that *Pickup*, *Easterbrook* and *Mosher* are combinable to render the Appellant's invention obvious is faulty. Consequently, Appellant respectfully requests that the rejections be overturned with respect to dependent claims 6, 8, 30, and 32.

In addition, dependent claims 6, 8, 30, and 32 each further include the distinguishing feature of a notice consisting of "the automated delivery of a preexisting notification email message to an alternate email address for said users." The Examiner's final rejection has failed to demonstrate that is distinguishing feature was known in the prior art. Specifically, the Examiner cites paragraph 57 of *Pickup* as disclosing this distinguishing feature but, as demonstrated by the complete reproduction of paragraph 57 below, paragraph 57 of *Pickup* does not teach, disclose or render obvious the limitations of dependent claims 6, 8, 30, and 32 concerning "automated delivery", "a preexisting notification email message", or "to an alternate email address for said users." Consequently, Appellant respectfully requests that, on this basis alone, the rejections be overturned with respect to dependent claims 6, 8, 30, and 32.

[0057] In order to safeguard against failure, a backup system 5 is provided at a different location. Backup system 5 also has a mail server 6 and a web server 7 with a mirrored copy of the database. This enables the redirection service to continue to operate if errors or physical damage occurs at the site of production mail server 1 and production web server 2. In the event of catastrophic failure on the part of the mail server 1, incoming emails are automatically routed to a backup system located at a separate site. The backup server 7 stores and processes any mail until the primary mail server is brought back on line. An option exists to mirror the database associated with server 1 in real time with backup facilities.

Pickup, paragraph 57.

4. Rejection of Claims 7 and 31 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Wallach* and as being unpatentable over *Pickup* in view of *Easterbrook* and further in view of *Mosher*.

For the reasons stated above in section 1 and section 2, Examiner's position that *Pickup*, *Easterbrook* and *Wallach* are combinable to render the Appellant's invention obvious is faulty and Examiner's position that *Pickup*, *Easterbrook* and *Mosher* are combinable to render the Appellant's invention obvious is faulty. Consequently, Appellant respectfully requests that the rejections be overturned with respect to dependent claims 7 and 31.

In addition, dependent claims 7 and 31 each further include the distinguishing feature of "periodically pinging email addresses on said primary email system and evaluating whether a response is received from said email addresses." The Examiner's final rejection has failed to demonstrate that is distinguishing feature was known in the prior art. Specifically, the Examiner cites paragraph 57 of *Pickup* as disclosing this distinguishing feature but, paragraph 57 of *Pickup* makes no mention of periodically pinging email addresses or evaluating the response from such activity. Consequently, Appellant also respectfully requests that, on this basis alone, the rejections be overturned with respect to dependent claims 7 and 31.

5. Rejection of Claim 17 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of *Katsikas*.

The Examiner's position that *Pickup*, *Wallach* and *Katsikas* are combinable to render Appellant's independent claim 17 obvious is faulty because the cited prior art does not teach, disclose or otherwise render obvious the limitation "wherein said redirected email messages have a low-priority designation" as recited in independent claim 17. The Examiner only cites *Pickup* as disclosing this limitation. However, *Pick-up* does not teach or disclose designating certain messages as low priority. The Examiner correctly points out that, in *Pickup*, "all email messages are redirected to the backup mail server regardless of the priority." However, that is exactly why *Pickup* does not teach this element of Appellant's independent claim 17. Appellant claims a method wherein the redirected email messages have a low-priority designation. *Pickup* does not teach a system in which redirected email messages have a designated priority and *Wallach* and *Katsikas* fail to cure this deficiency of *Pickup*. Accordingly, the cited prior art does not teach each and every element of Applicant's Claim 17. Since all claim limitations are not taught, disclosed or rendered obvious by the cited prior art, the Examiner has not established a prima facie obviousness with respect to Claim 17 and Applicant respectfully requests that this rejection be withdrawn with respect to Claim 17.

6. Rejection of Claim 18 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of *Easterbrook*.

The Examiner's position that *Pickup*, *Easterbrook* and *Wallach* are combinable to render the Appellant's independent claim 18 obvious is faulty for at least the following five reasons.

First, the cited prior art does not teach, disclose or otherwise render obvious the limitation "changing a domain name system designation of a primary email system responsive to detection of an outage of the primary email system" as recited in independent claim 18. The Examiner incorrectly asserts that paragraph 57 of *Pickup* teaches the limitation of independent claim 18 based on the Examiner's assumption that a "domain name needs to be changed in order to redirect an email message to a different server." However, this assumption is not necessarily true. For example, *Wallach* teaches that "when the primary server fails, the secondary server is immediately substituted as the primary server with identical configurations." *Wallach*; col. 2, lines 28-30. In such a case, the domain name is not changed (as the Examiner has assumed) but,

instead, the secondary server assumes the identity of the primary server. The Examiner cannot assume that a process described broadly in the art reads on the specific process recited in a claim. The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279 (1944). Consequently, this distinguishing feature of independent claim 18 is not taught, disclosed or rendered obvious.

Second, similar to independent claims 1 and 25, independent claim 18 includes the distinguishing feature of “delivering said email messages from said alternate facility to said wireless devices.” As set forth in section 1.A, the cited prior art discloses sending notifications but not delivering email messages themselves to a wireless device. Consequently, this distinguishing feature of independent claim 18 is not taught, disclosed or rendered obvious.

Third, similar to independent claims 1 and 25, independent claim 18 includes the distinguishing feature of “notifying an intended recipient of said email messages that said messages are available on said recipient’s wireless device through said alternate facility at such time as said redirection of said email messages has been implemented.” As set forth in section 1.A, the cited prior art does not disclose sending notifications that and when the primary system have been engaged or disengaged. Consequently, this distinguishing feature of independent claim 18 is not taught, disclosed or rendered obvious.

Fourth, for the same reasons set forth in section 1.B, the Examiner has not set forth a rational underpinning for combining the cited prior art.

Fifth, for the same reasons set forth in section 1.C, a combination or modification of the cited prior art does not provide a reasonable expectation of success or predictability that would likely lead one of ordinary skill in the art to arrive at Appellant’s independent claim 18.

For all of the foregoing reasons, Applicant respectfully requests that this rejection be withdrawn with respect to independent claim 18.

7. Rejection of Claims 19 and 21 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* further in view of *Easterbrook*.

The Examiner’s position that *Pickup*, *Easterbrook* and *Wallach* are combinable to render the Appellant’s independent claim 19 and its dependent claim 21 obvious is faulty for at least the

following four reasons. First, similar to independent claims 1 and 25, independent claim 19 includes the distinguishing feature of “delivering, via said alternate email address, the email messages to said wireless device responsive to detection of an outage of a primary email system.” As set forth in section 1.A, the cited prior art discloses sending notifications but not delivering email messages themselves to a wireless device. Consequently, this distinguishing feature of independent claim 19, and its dependent claim 21, is not taught, disclosed or rendered obvious.

Second, similar to independent claims 1 and 25, independent claim 19 includes the distinguishing feature of “notifying an intended recipient of said email messages that said messages are available on said recipient’s wireless device through said alternate facility at such time as said redirection of said email messages has been implemented.” As set forth in section 1.A, the cited prior art does not disclose sending notifications that and when the primary system have been engaged or disengaged. Consequently, this distinguishing feature of independent claim 19, and its dependent claim 21, is not taught, disclosed or rendered obvious.

Third, for the same reasons set forth in section 1.B, the Examiner has not set forth a rational underpinning for combining the cited prior art.

Fourth, for the same reasons set forth in section 1.C, a combination or modification of the cited prior art does not provide a reasonable expectation of success or predictability that would likely lead one of ordinary skill in the art to arrive at Appellant’s independent claim 19.

For all of the foregoing reasons, Applicant respectfully requests that this rejection be withdrawn with respect to independent claim 19 and its dependent claim 21.

8. Rejection of Claims 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over *Pickup* in view of *Wallach* and *Easterbrook* as applied to claim 21 and further in view of *Katsikas*.

Claims 22 and 23 depend from Claim 21. Applicant respectfully traverses this rejection and submits that, for the reasons set forth above with respect to Claim 21, this rejection be withdrawn with respect to Claims 22 and 23.

CONCLUSION

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time. Appellant has pointed out with specificity the manifest error in the Examiner's rejections, and the claim language that renders the invention patentable over the combination of references. Appellant, therefore, respectfully requests that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,

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APPENDIX A

1. A method for providing backup electronic messaging services to wireless devices during outages, comprising:

sending email messages from a primary email system to a user's wireless device;

when said primary email system is unavailable, redirecting said email messages from said primary email system to a secondary email system and from said secondary email system to said user's wireless device;

notifying said user that said email messages are available on said user's wireless device through said secondary email system at such time as said redirection of said email messages has been implemented;

at such time as said primary email service becomes available, redirecting said email messages from said secondary email system to said primary email system and from said primary email system to said user's wireless device;

notifying said user that said email messages are available on said user's wireless device through said primary email system at such time as said redirection of said email messages has been implemented; and

synchronizing said email messages received on said secondary email system while said primary email system was unavailable with the messages in said primary email system.

2. The method of claim 1, wherein said primary email system is located remotely from said secondary email system and is interconnected to said secondary email system through the Internet.

3. The method of claim 1, wherein a determination of when said primary email system is unavailable is performed manually by assessing whether an error message has been received indicating an inability to deliver an email message to said primary email system.

4. The method of claim 1, wherein said email messages to all addresses on said primary email system are automatically redirected to said secondary email system at any time any of said email addresses on said primary email system are unavailable.

5. The method of claim 1, wherein said email messages to all email addresses on said primary email system are redirected to said secondary email system after some, but less than all, of said email messages are unavailable.

6. The method of claim 1, wherein said step of notifying said user that said email messages are available on said secondary email system further includes the automated delivery of a preexisting notification email message to an alternate email address for said users.

7. The method of claim 1, wherein assessing the time at which said primary email system is available includes periodically pinging email addresses on said primary email system and evaluating whether a response is received from said email addresses.

8. The method of claim 1, wherein said notification of said user that said email messages are again available on said primary email system consists of the automated delivery of a preexisting notification email message to an alternate email address for said user.

9. The method of claim 1, wherein the ability to redirect said email messages from said primary email system to said secondary email system is password protected.

10. The method of claim 1, wherein one or more of said wireless devices is selected from the group consisting of personal digital assistant devices, cell phones and pagers.

17. A method for intercepting and redirecting email messages to wireless devices, comprising:

redirecting, responsive to detection of an outage of a primary email system, email messages intended to be delivered to said primary email system to an SMTP host; and

wherein said redirected email messages have a low priority designation.

18. A method for intercepting and redirecting email messages to wireless devices, comprising:

changing a domain name system designation of a primary email system responsive to detection of an outage of the primary email system;

directing inbound email messages to an alternate facility; and

delivering said email messages from said alternate facility to said wireless devices; and

notifying an intended recipient of said email messages that said messages are available on said recipient's wireless device through said alternate facility at such time as said redirection of said email messages has been implemented.

19. A method for delivering backup messages to wireless devices, comprising:

maintaining a mapping of alternate email addresses of the wireless devices;

delivering, via said alternate email address, the email messages to said wireless device responsive to detection of an outage of a primary email system;

wherein said step of delivering is performed during said outage of a primary path for delivering said email messages; and

notifying an intended recipient of said email messages that said messages are available on said recipient's wireless device through said alternate facility at such time as said redirection of said email messages has been implemented.

21. The method according to claim 19, further comprising:

pulling messages from a mailbox within a secondary email system to the wireless device.

22. The method of claim 21 wherein said mailbox is a pop3 mailbox.

23. The method of claim 21 wherein said mailbox is an imap4 mailbox.

25. A system for providing backup electronic messaging services to wireless devices during outages, comprising:

a primary email system, wherein said primary email system is configured for delivering email messages to said wireless devices;

a secondary email system, wherein said secondary email system is configured for delivering said email messages to said wireless devices at such time as said primary email system is unavailable;

at such time as said primary email system becomes unavailable, users of said wireless devices are notified that said primary email system is unavailable; and

at such time as said primary email service again becomes available, redirecting said email messages from said secondary email system back to said primary email system for delivery to said wireless devices, notifying said users that said email messages are available on said users wireless device through said primary email system, and synchronizing said email -messages

received on said secondary email system-while said primary email-system was unavailable with the messages in said primary email system.

26. The system of claim 25, wherein said primary email system is located remotely from said secondary email system and is interconnected to said secondary email system through the Internet.

27. The system of claim 25, wherein said system is adapted to manually detect when said primary email system is unavailable by assessing whether an error message has been received indicating an inability to deliver said email messages to said primary email system.

28. The system of claim 25, wherein said email messages to all addresses on said primary email system are automatically redirected to said secondary email system at any time any of said email addresses on said primary email system are unavailable.

29. The system of claim 25, wherein said email messages to all email addresses on said primary email system are redirected to said secondary email system after some, but less than all, of said email messages are unavailable.

30. The system of claim 25, wherein said notification to said user that said email messages are available on said secondary email system further includes an automated delivery of a preexisting notification email message to an alternate email address for said users.

31. The system of claim 25, wherein assessing a time at which said primary email system is available includes periodically pinging an email addresses on said primary email system and evaluating whether a response is received from said email addresses.

32. The system of claim 25, wherein notifying said user that said email messages are again available on said primary email system consists of the automated delivery of a preexisting notification email message to an alternate email address for said user.

33. The system of claim 25, wherein an ability to redirect said email messages from said primary email system to said secondary email system is password protected.

34. The system of claim 25, wherein one or more-of said wireless devices is selected from the group consisting of personal digital assistant devices, cell phones and pagers.

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APPENDIX B
EVIDENCE APPENDIX

None

APPENDIX C
RELATED PROCEEDINGS APPENDIX

None